



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,496	02/07/2001	David M. Lubman	UM-06106	8813
23535	7590	03/03/2005	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			MAHATAN, CHANNING	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/778,496

Applicant(s)

LUBMAN ET AL.

Examiner

Channing S Mahatan

Art Unit

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-6, 8-24 and 26-37.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 1 Sheet  
13. ☐ Other: \_\_\_\_\_.

C. Ma / F  
March 1, 2005

Continuation of 11. does NOT place the application in condition for allowance because: Applicants have argued in the 'Response', filed 21 January 2005, (pages 10-11) that the Examiner has failed to properly consider rebuttal evidence, particularly with regard to the declaration under 36 C.F.R. 1.132 by Dr. David Lubman to overcome the rejection under 35 U.S.C. 103(a) of the references Chong et al. taken in view of Richmond et al. further in view of Pandey et al. Applicants indicate that the declaration by Dr. David Lubman provides: 1) an explanation from a scientific perspective of what is absent from a reading of the cited references; and 2) direct and uncontradicted evidence as to why there is no motivation to combine the prior art references and why, even if combined, the references do not provide the claimed invention. These arguments and assertions are not not agreed with. The declaration was thoroughly considered by the Examiner, however, Dr. David Lubman provided an expert opinion of claim elements supposedly not found in the cited reference without any explanation as to why such claim elements are considered to be absent in view of the Examiner's cited portion of said elements in the references. For example, the Examiner previously indicated in the 'Non-Final Office Action', mailed 18 May 2004 (page 4, lines 9-10) that Figure 1 depicts side-by-side protein profile maps, however, the declaration (point 5, page 2, lines 11-12) states: "The Chong reference does not describe the side by side display of protein profile maps" without any further explanation as to why Figure 1 should not be interpreted to represent said claim element. Thus, points 4-7, 11-15, and 20-23 in the declaration are also viewed as representing opinions of the cited references and fails to provide factual evidence and/or an explanation that these elements are not present in the cited references in view of the Examiner's cited portion of said elements in the references. Points 9, 17, 18, 26, and 27 in the declaration appear to address the lack of motivation for one of skill in the art to combine the references Chong et al. taken in view of Richmond et al. further in view of Pandey et al. However, as previously indicated by the Examiner one of ordinary skill in the art at the time of the invention would have practiced Chong et al., protein profiling of whole cell lysates wherein protein fractions are separated by non-porous reverse phase HPLC and analyzed using matrix-assisted laser desorption/ionization time-of-flight mass spectrometry (MALDI-TOFMS), with Richmond et al., graphical display of colour intensity bands representing (intensity/mass) from liquid chromatography information side-by-side, further with Pandey et al. differential display of protein data from mass spectrometry (refer to 'Final Office Action' mailed 17 November 2004, page 5, lines 17--22). Since: 1) Richmond states that colored computer screen pictures and 3D maps provide quick and easy way of delivering liquid chromatography (HPLC) data to laboratories in traditional synthetic chemistry, combinatorial chemistry and natural products chemistry (refer to 'Final Office Action' mailed 17 November 2004, page 4, lines 17-20); and 2) Pandey et al. describes the application of differential display in the field of proteomics, particularly mass spectrometry protein profile maps for a more faster, more convenient, and more comprehensive analysis of protein (refer to 'Final Office Action' mailed 17 November 2004, page 6, lines 1-4). Applicants argue that Verentchikov fails to: 1) solve the deficiencies of Chong or Richmond; 2) describe the need for separation steps prior to mass spectroscopy; and 3) indicate "switchable, multichannel valve". However, this is also not agreed with. As indicated in the 'Final Office Action' mailed 17 November 2004 Verenchikov was applied to demonstrate that one of ordinary skill in the art at the time of the instant invention would utilize electrospray-ionization-orthogonal acceleration-time-of-flight mass spectrometry (instant claims 21 & 34) in combination with Chong et al. further in view of Richmond et al. Applicants have only asserted elements that are not taught and have failed to address the reasons why one would not be motivated for the combination of these references. In addressing Applicants' statement ('Response' filed 21 January 2005, page 14, lines 27-30) that "the Examiner merely recites the Applicants definition of a switchable, multichannel valve, but fails to specifically describe how the cited art teaches a valve that allows multiple apparatuses to be connected to one sample handler". Applicants are directed to the 'Final Office Action' mailed 17 November 2004 which clearly indicates the Beckman System Gold HPLC has a programmable delivery module with a dual pump which is interpreted to be switchable and multichannel, and that the system permits the control of the pump and external modules which is interpreted to be additional pumps, and is thus multi-channel valve in nature. Therefore, the rejections of claims 1-6, 8-20, and 26-37 under 35 U.S.C. 103(a) are maintained for reasons of record.

*Ardin H. Marschel* 3/1/05  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER